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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,138	12/13/2000	Joane Goodroe	GOOD1 (11652.107070)	8196

7590 05/19/2005
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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/736,138	Applicant(s) GOODROE ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-20, 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 17 February 2005. Claims 2-7, 11, 18-20 have been amended. Claims 1, 21-23 have been cancelled. Claims 24-26 have been newly added. Claims 2-20, 24-26 are currently pending.

Specification

2. The amendment filed 17 February 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc. The added material which is not supported by the original disclosure is as follows:

- "a first set of a resource," as disclosed in newly added claim 25, line 3;
- "collecting data related to the use of the at least a portion of the first set of the resource utilized," as disclosed in newly added claim 25, lines 6-7;
- "determining from at least a portion of the data reduction opportunities for the resource for the specific procedure," as disclosed in newly added claim 25, lines 8-9;

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- "establishing a benchmark related to the utilization of the resource during the specific clinical procedure, the benchmark correlating to a second set of the resource," as disclosed in newly added claim 25, lines 10-11;
- "standardizing the specific clinical procedure based upon the benchmark, such that in a subsequent specific clinical procedure, the second set of the resource is allocated for the subsequent specific clinical procedure," as disclosed in newly added claim 25, lines 12-14.

In particular, Applicant does not point to, nor was the Examiner able to find, any support for this newly added language within the specification as originally filed on 13 December 2000. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 13 December 2000.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Newly added claims 25-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Independent claim 25 recites limitations that are new matter, as discussed above, and is therefore rejected.

(B) Dependent claim 26 incorporates the features of independent claim 25, through dependency and is also rejected.

6. The rejection of claims 21-22 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 17 February 2005.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

8. Claims 2-20, 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for substantially the same reasons given in the previous Office Action (paper number 11082004). Further reasons appear below.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

(A) In the present case, newly added claims 24-26 only recite abstract ideas. The recited claims detailing the steps of collecting data, establishing a benchmark and standardizing a clinical procedure do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute different parts of a method for increasing resource utilization efficiency.

Furthermore, Examiner notes that newly added claim 24 recites a "computer-implemented method" in the preamble. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a

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standardized clinical procedure (i.e., repeatable) that can be used in allocating and utilizing resources (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 24-26 are deemed to be directed to non-statutory subject matter.

(B) Claims 2-7, 11, 18-20 have been amended to change their dependencies from cancelled claim 1 to newly added claim 24. However, newly added claim 24 is directed to non-statutory subject matter as discussed above. As such, the rejection of claims 2-7, 11, 18-20 under 35 U.S.C. 101 still stands.

(C) Claims 8-10, 12-17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 11082004, section 5, pages 2-4), and incorporated herein.

9. The rejection of claims 1, 23 under 35 U.S.C. 101, for being directed to non-statutory subject matter is hereby withdrawn due to the amendment filed 17 February 2005.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-7, 9-18, 20, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCartney, U.S. Patent Number 5, 778, 345 in view of Dang, U.S. Patent Number 5, 835, 897 for substantially the same reasons given in the prior Office Action (paper number 11082004). Further reasons appear hereinbelow.

(A) The amendments to claims 3-7, 11, 18, 20 appear to have been made merely to correct minor typographical or grammatical errors and to change dependencies from cancelled claim 1. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 11082004, section 7, pages 4-9), and incorporated herein.

(B) Claims 9-10, 12-17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 11082004, section 7, pages 4-9), and incorporated herein.

(C) As per newly added claim 24, McCartney and Dang teach a computer-implemented method for increasing resource utilization efficiency and identifying areas to

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enhance quality (McCartney; Figure 1, column 6, lines 10-14), said method comprising the steps of:

- collecting data related to a specific medical service (reads on clinical procedure) (McCartney; column 9, lines 15-29, column 12, lines 30-35);
- establishing a benchmark related to the specific medical service (reads on clinical procedure) based upon at least a portion of the data (McCartney; see at least column 12, lines 30-35) and
- creating or engineering quality improvement protocols (reads on standardizing) the specific clinical procedure based upon said benchmark (Dang; column 19, lines 40-64, column 36, lines 15-19).

The motivations for combining the respective teachings of McCartney and Dang are as given in the rejection of claim 1 in the previous Office Action (paper number 11082004), and incorporated herein.

(D) As per newly added claim 25, McCartney and Dang teach a computer-implemented method for increasing resource utilization efficiency and identifying areas to enhance quality (McCartney; Figure 1, column 6, lines 10-14), said method comprising the steps of:

- allocating a first set of a resource (McCartney; see at least Abstract, column 5, line 45 to column 6, line 39, column 12, lines 30-65, column 18, lines 17-49);
- performing a specific clinical procedure during which time at least of portion of the first set of the resource is utilized (McCartney; column 9, lines 15-38);

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collecting data related to the use of the at least a portion of the first set of the resource utilized performing the specific clinical procedure (McCartney; column 5, line 45 to column 6, line 39, column 9, lines 15-38);

determining from at least a portion of the data potential cost savings (reads on reduction opportunities for the resource for the specific clinical procedure) (McCartney; column 18, lines 30-37);

establishing a benchmark related to the utilization of the resource during the specific clinical procedure, the benchmark correlating to a second set of the resource (McCartney; column 12, lines 30-35, column 18, lines 17-49, column 21, lines 45-56); and
creating or engineering quality improvement protocols (reads on standardizing) the specific clinical procedure based upon the benchmark, such that in a subsequent specific clinical procedure, the second set of the resource is allocated for the subsequent specific clinical procedure (Dang; column 19, lines 40-64).

The motivations for combining the respective teachings of McCartney and Dang are as given in the rejection of claim 1 in the previous Office Action (paper number 11082004), and incorporated herein.

12. Claims 2, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCartney, U.S. Patent Number 5, 778, 345 in view of Dang, U.S. Patent Number 5, 835, 897 as applied to claim 1 above, and further in view of article, "Cost Control Incented Many Ways Despite OIG Ruling on Gainsharing, "April 12, 2000, Physician Compensation Report, URL: <http://www.findarticles.com/p/articles/mi_m0FBW/is_4_1/ai_61933228/print>, hereinafter

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known as CostControl for substantially the same reasons given in the prior Office Action (paper number 11082004). Further reasons appear hereinbelow.

(A) The amendments to claim 2 appear to have been made merely to correct minor typographical or grammatical errors and to change dependencies from cancelled claim 1. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 11082004, section 8, pages 10-11), and incorporated herein.

(B) As per newly added claim 26, McCartney, Dang and CostControl teach a method as analyzed and discussed in claim 25 above further comprising the step of rewarding physicians' efforts to reduce costs by providing a share of savings in response to utilizing the standardized specific clinical procedure (CostControl; paragraphs 1-2, 5, 8-9).

The motivations for combining the respective teachings of McCartney and Dang are as given in the rejection of claim 1 in the previous Office Action (paper number 11082004), and incorporated herein.

The motivations for combining the respective teachings of McCartney, Dang and CostControl are as given in the rejection of claim 2 in the previous Office Action (paper number 11082004), and incorporated herein.

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13. Claims 8, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCartney, U.S. Patent Number 5, 778, 345 in view of Dang, U.S. Patent Number 5, 835, 897 as applied to claims 1 and 7 above, and further in view of Jones et al., U.S. Patent Number 6, 117, 073 for substantially the same reasons given in the prior Office Action (paper number 11082004).

Further reasons appear hereinbelow.

(A) Claim 8 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 11082004, section 9, pages 11-12), and incorporated herein.

(B) The amendments to claim 19 appear to have been made merely to correct minor typographical or grammatical errors and to change dependencies from cancelled claim 1. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 11082004, section 9, pages 11-12), and incorporated herein.

Response to Arguments

14. Applicant's arguments filed 17 February 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 17 February 2005.

(A) At pages 7-10 of the 17 February 2005 response Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added limitations of the amendment filed 17 February 2005, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of McCartney, Dang, CostControl and Jones, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 11082004), and incorporated herein. In particular, Examiner notes that the recited features of "collecting data related to a specific clinical procedure" are taught by the combination of applied references. Please note that Examiner interprets McCartney's recitation of "[a] benchmark module or procedure 700 computes efficiency indicators ... for one or more types of medical service". These indicators are compared against benchmark values to identify areas where the subject health care provider is inefficient" (emphasis added) (McCartney; column 9, lines 15-29, column 12, lines 30-35) as teaching the argued limitations.

With regard to Applicant's assertion in paragraph 4 of page 7 of the 17 February 2005 response that "cost data is not utilized" in the McCartney reference, Examiner respectfully disagrees. Examiner interprets McCartney's recitation of "the potential savings resulting from achieving different benchmarks are calculated. This information about potential savings is key to decision making and the process of running the software for various scenario's marks this

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system an invaluable tool for health administrators and planners" (McCartney; column 18, lines 30-37) as teaching determining potential cost savings (reads on "reduction opportunities"), as recited in newly added claim 25.

At pages 7-10 of the 17 February 2005 response response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, the issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

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Conclusion

15. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please

label "PROPOSED" or "DRAFT" on the front page of

the communication and do NOT sign the

communication.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.


18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

May 16, 2005



JOSEPH THOMAS
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